

## REMARKS

Claims 1-16 are pending in the application. Claims 1, 8, and 14 are independent. By the foregoing Amendment, Applicant has amended claim 8 and 14. These changes are believed to introduce no new matter and their entry is respectfully requested.

### Objection to the Drawings

In the Office Action, the Examiner objected to the drawings for failure to show every feature of the invention specified in the claims. Specifically, the Examiner stated that the reference DAC 314 is described in the Specification at [0033] but not found in the drawings. By the foregoing Amendment, Applicants have amended the Specification to delete reference to the DAC 314 being located in Figure 3. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the objection to the Drawings.

### Objection to the Specification

In the Office Action, the Examiner objected to the Specification citing informalities. Specifically, the Examiner stated that the transponder 410 should be transponder 412. By the foregoing Amendment, Applicants have amended the Specification to accommodate the Examiner. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the objection to the Specification.

### Rejection of Claims 1-4 and 8-9 Under 35 U.S.C. §102(e)

In the Office Action, the Examiner rejected claims 1-4 and 8-9 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2004/0028099 A1 to Hongo et al. (“Hongo”). A claim is anticipated only if each and every element of the claim is found, either expressly or inherently, in a reference. (MPEP §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. *Id. citing Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236 (Fed. Cir. 1989)). Applicant respectfully traverses the rejection.

Independent claim 1 recites in pertinent part “converting an optical beam emitted from a laser to a current proportional to a power of the optical beam using a monitor photodiode;

*adjusting the current from the monitor photodiode* up or down using a thermistor and resistor network *to compensate for a change in optical fiber tracking*” (emphasis added). Amended claim 8 recites in pertinent part “first circuitry coupled to receive the current and to adjust the current as temperature changes and *to compensate for changes in optical fiber tracking*” (emphasis added). In the Office Action, the Examiner states that Hongo teaches “adjusting the current from the monitor photodiode up or down using a thermistor and resistor network to compensate for a change in optical fiber tracking” at paragraph [0038] lines 2-6. Applicant respectfully disagrees with the Examiner’s characterization of Hongo.

Hongo appears to utilizing the monitor photodiode 4 in the semiconductor laser module 1 to maintain the optical output of the semiconductor laser 2 constant. (See [0075].) Hongo does not appear to be concerned with optical fiber tracking. In fact, nowhere in Hongo is tracking mentioned. Applicant respectfully submits therefore that Hongo fails to teach the identical invention as that recited in claims 1 and 8 and as such claims 1 and 8 are patentable over Hongo. Claims 2-4 and 9 properly depend from claims 1 and 8, respectively, which Applicant submits are patentable. Accordingly, Applicant respectfully submits that claims 2-4 and 9 are patentable for at least the same reason that claims 1 and 8 are patentable. MPEP §2143.03 provides that if an independent claim is unobvious, then any claim depending from the independent claim is unobvious (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). It follows that if an independent claim is patentable over the art of record, then any claim depending from the independent claim is patentable over the art of record. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1-4 and 8-9.

#### Rejection of Claims 5-7 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 5-7 as unpatentable over Hongo in view of U.S. Patent No. 5,812,582 to Gilliland et al. (hereinafter “Gilliland”). To establish a *prima facie* case of obviousness, an Examiner must show that that there is some suggestion or motivation to modify a reference to arrive at the claimed invention, that there is some expectation of success, and that the cited reference teaches each and every element of the claimed invention. (MPEP §2143.) Applicant respectfully traverses the rejection. Claims 5-7 properly depend from claim 1 and as such are patentable over the art of record for at least the

same reasons that claim 1 is patentable over the art of record. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 5-7.

Rejection of Claim 10 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 10 as unpatentable over Hongo in view of U.S. Patent No. 5,383,208 to Queniat et al. (hereinafter “Queniat”). Applicant respectfully traverses the rejection. Claim 10 properly depends from claim 8 and as such is patentable over the art of record for at least the same reasons that claim 8 is patentable over the art of record. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 10.

Rejection of Claim 11 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 11 as unpatentable over Hongo in view of Queniat in further view of U.S. Patent No. 6,795,656 B1 to Ikeuchi et al. (hereinafter “Ikeuchi”). Applicant respectfully traverses the rejection. Claim 11 properly depends from claim 8 and as such is patentable over the art of record for at least the same reasons that claim 8 is patentable over the art of record. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 11.

Rejection of Claim 12 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 12 as unpatentable over Hongo in view of Queniat in further view of U.S. Patent No. 6,055,251 to Ouchi et al. (hereinafter “Ouchi”). Applicant respectfully traverses the rejection. Claim 12 properly depends from claim 8 and as such is patentable over the art of record for at least the same reasons that claim 8 is patentable over the art of record. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 12.

Rejection of Claim 13 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 13 as unpatentable over Hongo in view of Queniat in further view of Gilliland. Applicant respectfully traverses the rejection. Claim 13 properly depends from claim 8 and as such is patentable over the art of record for at least the

same reasons that claim 8 is patentable over the art of record. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 13.

Rejection of Claims 14-16 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 14-16 as unpatentable over U.S. Patent No. 6,621,621 to Jones et al. (hereinafter “Jones”) in view of Hongo. Applicant respectfully traverses the rejection.

Amended independent claim 14 recites in pertinent part “a transponder having a laser to emit light, a photodiode coupled to receive light from the laser and to convert the light to a current, first circuitry coupled to receive the current and to adjust the current as temperature changes, and second circuitry coupled to receive the adjusted current and to provide the adjusted current to the laser to adjust light emitted by the laser, wherein the first circuitry is further *to compensate for changes in optical fiber tracking*” (emphasis added). Applicant respectfully submits that neither Jones nor Hongo alone or in combination teaches or suggests circuitry to compensate for changes in optical fiber tracking. As such, the combination of Jones in view of Hongo fails to teach or suggest each and every element of claim 14 and claim 14 is thus patentable over Jones in view of Hongo. Claims 15-16 properly depend from claim 14 and as such are patentable over Jones in view of Hongo for at least the same reasons that claim 14 is patentable over Jones in view of Hongo. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 14-16.

## CONCLUSION

Applicant submits that all grounds for rejection have been properly traversed, accommodated, or rendered moot, and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.


Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN



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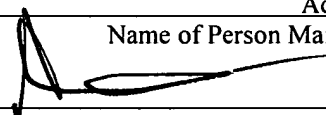
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